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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,197	10/16/2001	John W. Davis	FC01402	5761

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SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
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KENILWORTH, NJ 07033-0530

EXAMINER

DAVIS, ROBERT B

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 05/07/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,197

Applicant(s)

DAVIS ET AL.

Examiner

Robert B. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 8-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-7, in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the grouping of claims must be capable of separate manufacture, use, or sale as claimed, and are patentable (novel and unobvious) over each other and that there is no serious burden in searching all of the inventions. This is not found persuasive because the article of claims 13-16 can be made by other methods as listed on lines 28-32 of page 7 of the specification. Accordingly, since adhesive bonding and RF welding can be used to produce the article it is clear that patentability of the article is not dependent upon the apparatus or the method of using the apparatus to mold such an article. Claim 13 is a product by process claim. It is clearly established precedent that patentability of such a claim is dependent upon the structure of the product and not the process of manufacture. Accordingly, claim 13 is being grouped with product claims 14-16. In regards of the restriction between the apparatus and process and the argument that examination of both groups does not present a serious burden to the Patent Office. This is not found persuasive because of applicants allegation that joinder of these distinct inventions would not present a serious burden to the U. S. Patent and Trademark Office. This allegation relied on the unsupported assumption that the search and examination of both inventions would be coextensive. However, the issues raised in the examination of apparatus claims are divergent from those raised in the examination of process claims. Further, while there may be some overlap in the searches of the two inventions, there is

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no reason to believe that the searches would be identical. Therefore, based on the additional work involved in searching and examining both distinct inventions together, restriction of the distinct inventions is clearly proper. As an example, the apparatus as claimed can be used to practice another and materially different process such moving the lifter to clamp the insert between the lifter and the inward lip, closing the mold and then injecting resin at a high pressure into the mold after closing. It is clear that the apparatus as claimed can be use to perform a low pressure molding process as claimed in claim 8 or a high pressure molding process as described by the examiner. Since the low pressure method of supplying the molding material to the cavity and then closing the mold halves would be allowable over an apparatus which clamped an insert between the lifter and the inward lip, then closed the mold and then injects high pressure resin into the mold cavity, it is submitted that the process is capable of being patentable over the apparatus.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 8-16 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Noiro et al (6,054,087: figures 1-9).

Noiro et al teach an apparatus for insert molding comprising: an upper mold half (6), a lower mold half (7) for mating with the upper mold half to provide a molded part cavity as shown in figure 3, the lower mold also has an elevator opening as shown in figures 1 and 2, and an inwardly directed lip as shown in figures 1 and 2. The inwardly directed lip is located on mold elements (7 and 8) as shown in figure 2 adjacent the ends of elements (11 and 12) protruding into the molding cavity. The reference further teaches a lifter (3) for supporting an insert (20) to be secured to a molded article as shown in figure 7. A lifting arrangement (mold end plate 1) is used to lower and raise the lifter (3) such that the insert (20) is clamped between the lifter (3) and the inwardly directed lip as shown in figures 3 and 4.

5. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Kikuchi et al (5,840,225: figures 1-8).

Kikuchi et al teach an apparatus for insert molding comprising: an upper mold half (13), lower mold half (formed by side mold portions (16) which form a molding cavity as shown in figure 7, the lower mold half has an elevator opening as shown in figure 1, and a lifter (15) positioned in the elevator opening to be raised and lowered to clamp an insert (21) between the lifter and the side mold portions (16) of the lower mold half. As shown in figure 5, the side mold portions have a collective inwardly protruding lip in the tapered surfaces that clamp the insert (21) between the lifter (15) and the side

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mold portions (16). The reference also teaches a base (18) having an in/out mechanism in the form of a hydraulic cylinder arrangement (column 3, lines 1-5) and the piston rod is clearly shown in figures 1 and 4. The cylinder is clearly mounted in a recess in the base (18).

Allowable Subject Matter

6. Claims 4-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art of record teach or suggest the apparatus of claim 1 having a retainer removably connected to the respective mold half within the elevator opening, the retainer including a dam flush with and removable from an inner wall defining the elevator opening and the retainer further including the inwardly extending lip connected to an end of the dam. The closest prior art (Hoza 2,241,599) teaches an inwardly directed lip as shown in the figure to clamp a portion of an upper (8) between the lip of the lower mold and the last (5), but the reference contains no suggestion or disclosure of an elevator having a lifter or a removable retainer having a dam and the inwardly extending lip as claimed in claim 4. Noirot et al and Kikuchi et al each fail to disclose or suggest a removable retainer as claimed in claim 4. In regards to claim 6, none of the prior art of record teach or suggest the apparatus of claim 1 further including a first slide plate having a first inclined cam surface, the lifter connected to the first slide plate, a second slide plate having a second cam surface in contact with the first cam surface

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and a moving arrangement for sliding the second slide plate relative to the first slide plate. The closest prior art Kikuchi et al discloses a cylinder arrangement for moving the lifter, but there is no suggestion in the prior art to modify the arrangement of Kikuchi et al to replace the cylinder with a slide plate arrangement as claimed in claim 6. In regards to claim 7, none of the prior teach or suggest two lower mold cavities corresponding to left and right insoles, one elevator opening in a lower portion of each lower mold cavity, one inwardly directed lip at each elevator opening, the elevator opening including two lifters for supporting an insert in correspondence with each said lower mold cavity, and the lifting arrangement raises and lowers the two lifters. Kikuchi et al and Noirot et al fail to disclose or suggest one lifting arrangement for two elevators cooperating with two inner lips of two elevator openings for forming right and left insoles in the same mold.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The remaining references display various sole and insert forming molds.

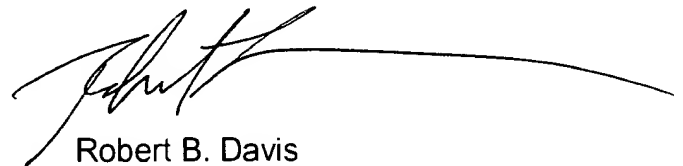
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Davis whose telephone number is 703-308-2625. The examiner can normally be reached on Monday-Friday 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Robert B. Davis
Primary Examiner
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5/5/03

May 5, 2003